REMARKS

The Final Office Action dated August 8, 2003 has been received and reviewed.

Claims 12-16 remain pending and under consideration in the above-referenced application. Each of claims 12-16 stands rejected.

Reconsideration of the above-referenced application is respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 12, 14, and 16 stand rejected under 35 U.S.C. § 102(b) for reciting subject matter which is purportedly anticipated by the subject matter described in U.S. Patent 5,327,652 to Balback (hereinafter "Balback").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Balback describes a hand-held apparatus 10 for notching seams in fabrics and other materials that are used in sewing. That apparatus 10 includes two opposed members, or jaws 18 and 19, that are configured to receive and oppose *two* cutting assemblies 22 and 26, which are to be used *together* to cut notches into the fabrics or other materials. FIGs. 2 and 3; col. 5, lines 35-62. Each cutting assembly 22, 26 includes a threaded aperture which is configured to receive a complementarily threaded connector 28, 30, such as a bolt, which also passes through the corresponding jaw 18, 19 of the hand-held apparatus 10. FIGs. 2 and 3; col. 6, lines 1-9. As shown in FIG. 3 of Balback, each threaded aperture extends completely through its respective cutting assembly 22, 26.

Independent claim 12 is drawn to an apparatus for forcing a die through a sheet of material. The apparatus of independent claim 12 includes, among other things, a first member, a second member, and handles associated with the first and second members. The first member includes a die receiving surface and a die retaining element. The second member includes a

substantially planar sheet supporting surface. The handles facilitate movement of at least one member of the first and second members toward the other member.

It is respectfully submitted that Balback does not expressly or inherently describe an apparatus that includes a sheet supporting surface. Rather, the apparatus 10 of Balback includes two jaws 18 and 19 that carry cutting assemblies 22 and 26 between which a sheet of fabric is to be held. *See, e.g.,* col. 6, lines 26-29.

Even assuming, for the sake of argument, that Balback does describe that the apparatus 10 thereof includes a sheet supporting surface, it is submitted that Balback does not expressly or inherently describe that any such sheet supporting surface of the apparatus 10 thereof is substantially planar. Neither jaw 18 nor jaw 19 of the apparatus 10 described in Balback is substantially planar. Rather, as FIG. 3 of Balback clearly shows, jaws 18 and 19 both include well portions 20 and 24 which are configured to receive cutting assemblies 22 and 26. *See also* col. 5, lines 39-41 and 46-49. Moreover, neither cutting assembly 22 nor cutting assembly 26 includes an exposed surface that could be considered to be substantially planar. Instead, cutting assemblies 22 and 26 include patterns of protruding cutting elements 34, as well as recesses that are configured to receive the cutting elements 34. *See* FIG. 3; col. 5, lines 63-68.

Furthermore, since the cutting assemblies 22 and 26 of the apparatus 10 of Balback are configured to cut through thick fabrics, such as leather (col. 7, lines 26-28), it is respectfully submitted that neither of the jaws 18 or 19 is configured to receive a substantially planar die, as required by independent claim 12. Rather, in order to cut through thick fabrics such as leathers, the cutting elements 34 and corresponding recesses of the cutting assemblies 22 and 26 must respectively protrude from and be depressed within the cutting assemblies significant distances (*i.e.,* a distance that is at least equal to the thickness of the thick fabric), which distances would certainly render the cutting assemblies 22 and 26 nonplanar.

For these reasons, it is respectfully submitted that Balback does not anticipate each and every element recited in independent claim 12. Therefore, under 35 U.S.C. § 102(b), independent claim 12 recites subject matter which is allowable over that described in Balback.

Claims 14 and 16 are both allowable, among other reasons, for depending from claim 12, which is allowable.

For these reasons, it is respectfully requested that the 35 U.S.C. § 102(b) rejections of claims 12, 14, and 16 be withdrawn and that each of these claims be allowed.

Rejections Under 35 U.S.C. § 103(a)

Claims 13 and 15 have both been rejected under 35 U.S.C. § 103(a).

M.P.E.P. § 706.02(j) sets forth the standard for a rejection under 35 U.S.C. § 103(a):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Balback in View of Benson

Claim 13 has been rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over that taught in Balback, in view of teachings from U.S. Patent 5,660,105 to Benson et al. (hereinafter "Benson").

The teachings of Balback have been summarized above.

Benson teaches a punching or embossing tool 10 that includes dies 20 and 22 which are configured to be opposed and biased against one another by compression members 24 and 26. FIG. 1; col. 3, lines 44-48. Each die 20, 22 includes an octagonal base 54, 64 and an insertion member 50, 60 protruding from a substantially planar surface of the octagonal base 54, 64. FIGs. 3 and 4; col. 4, lines 15-44. Each protruding insertion member 50, 60 also has an octagonal shape. *Id.*

Each compression member 24, 26 includes an elongate die receiving cavity 24a, 26a within which a base 54, 64 of a die 20, 22 is to be slidingly disposed and retained. FIG. 1; col. 3, lines 49-51. The protruding insertion member 50, 60 of each die 20, 22 extends through a

receiving slot 40, which communicates with the cavity 24a, 26a, as the base 54, 64 of that die 20, 22 is slid through the cavity 24a, 26a. An end of each receiving slot 40 has a half-octagonal profile 42 which corresponds to the octagonal shape of the insertion members 50, 60 of the dies 20, 22 and is, thus, configured to receive a protruding insertion member 50, 60 and retain a desired orientation thereof. FIGs. 3 and 4; col. 4, lines 8 and 9.

A retainer magnet 44 is disposed within each die receiving cavity 24a, 24b to hold the dies 20, 22 therein. FIGs. 3 and 4; col. 4, lines 10-44. The retainer magnets 44 also have a half-octagonal profile, which complements the octagonal shapes of the bases 54, 64 of the dies 20, 22. Col. 4, lines 10-14. The retainer magnets 44, including the magnetic fields generated thereby and their half-octagonal profiles, in combination with the complementary shapes of the bases 54, 64 of the dies 20, 22 and the die receiving cavities 24a, 26a and the complementary shapes of the ends of the receiving slots 40 and the insertion members 50, 60 of the dies 20, 22, hold the dies 20, 22 in a desired position within the die receiving cavities 24a, 26a.

Claim 13 recites that the die retaining element of claim 12, which is configured to receive a substantially planar die, is magnetic.

It is respectfully submitted that there are several reasons that a *prima facie* case of obviousness has not been established against claim 13.

First, neither Balback nor Benson, taken either separately or together, teaches or suggests each and every element of independent claim 12, from which claim 13 depends. In particular, Balback and Benson both lack any teaching of a sheet support surface, that a sheet supporting surface may be substantially planar, and of a die retaining element which is configured to receive a substantially planar die.

Second, one of ordinary skill in the art would not have been motivated by the teachings of Balback or Benson or by the knowledge that was generally available in the pertinent art before the filing date of the above-referenced application, to have combined the teachings of Balback with those of Benson in the manner that has been asserted. In particular, the apparatus 10 of Balback includes cutting assemblies 22, 26 that are held in place within respective jaws 18, 19 by way of bolts (*i.e.,* connectors 28, 30). In contrast, the apparatus 10 of Benson includes

dies 20, 22, cavities 24a, 24b, and magnets 44 that have complex, complementary shapes to hold the dies 20, 22 at a desired position and in a desired orientation. These complexities would prevent the substitution of a magnet for the bolt type connector 28, 30 of Balback.

Third, it is respectfully submitted that the complex shapes of the dies 20, 22 of the apparatus 10 of Benson teach away from the simpler cutting assembly 22, 26 designs of Balback, as well as from the substantially planar dies with which the apparatus of claim 13 is configured to be used.

Fourth, a magnet of the shape taught in Benson (half-octagonal) would not be useful to secure the cutting assemblies 22, 26 of Balback to the jaws 18, 19 of the apparatus 10 taught in Balback. Thus, one of ordinary skill in the art would have had no reason to expect the asserted combination of teachings from Balback and Benson to be successful.

For these reasons, it is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established against claim 13 and, thus, that claim 13 recites subject matter which is allowable over the teachings of Balback and Benson.

Balback in View of Sabin

Claim 15 stands rejected under 35 U.S.C. § 103(a) for purportedly reciting subject matter which is unpatentable over that taught in Balback, in view of the teachings of U.S. Patent 5,172,622 to Sabin (hereinafter "Sabin").

The teachings of Balback have been summarized above.

Sabin teaches a table-top die cutting apparatus 10 that includes a base 20 that is configured to support a sheet of paper of other material to be die-cut, a frame 18 extending upwardly from the base 20 and supporting a die receiving element 14, and a "shifting mechanism" 16 held in place by the frame 18 and associated with the die receiving element 14. Figs. 1 and 4; col. 3, lines 29-39. A pad 22 is located on the base 20. *Id.* The shifting mechanism 16 is basically a handle that, when moved, forces the die receiving element 14 downward toward the base 20 of the die cutting apparatus 10 and, thus, forces the cutting edges of a die 12 through a sheet 27 of paper or other material supported by the base. *Id.*

Claim 15 recites that at least a portion of the substantially planar sheet supporting member of the apparatus of claim 12 includes a cushioning element.

Claim 15 is allowable, among other reasons, for depending from claim 12, which is allowable.

In addition, it is respectfully submitted that a *prima facie* case of obviousness has not been established against claim 15 because one of ordinary skill in the art would not have been motivated to combine the teachings of Balback and Sabin in the manner that has been asserted. More specifically, Balback teaches a hand-held apparatus for cutting patterns into thick fabrics, such as leather, whereas the apparatus of Sabin is a table-top apparatus for cutting designs into thin sheets of material, such as papers. Moreover, the apparatus 10 of Balback, which includes two opposed cutting assemblies 22, 26, lacks a sheet supporting surface with which a pad 22 such as that taught in Sabin would be useful.

It is also respectfully submitted that one of ordinary skill in the art would have not reason to expect that incorporation of the pad 22 of Sabin into the apparatus 10 of Balback would be successful. To the contrary, since the apparatus 10 of Balback includes cutting assemblies 22, 26 that are configured to be opposed and to cut through a thick piece of fabric from opposite surfaces thereof, the application of a pad 22 of the type taught in Sabin to the cutting surface of one of the cutting assemblies 22, 26 of Balback would merely interfere with the intended operation of the apparatus 10 taught in Balback; *i.e.,* it would not work as intended.

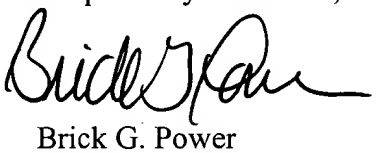
For these reasons, it is respectfully submitted that the asserted combination of teachings from Balback and Sabin does not support a *prima facie* case of obviousness against claim 15. It is, therefore, respectfully submitted that, under 35 U.S.C. § 103(a), claim 15 is allowable over the teachings of Balback and Sabin.

In view of the foregoing, it is respectfully requested that the 35 U.S.C. § 103(a) rejections of claims 13 and 15 be withdrawn.

CONCLUSION

It is respectfully submitted that each of claims 12-16 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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